

### **REMARKS/ARGUMENTS**

Prior to entry of this Amendment, claims 9-15 and 19-32 were pending in this application. Claims 9, 15, 19, and 28 have been amended, claim 33 and 34 has been added, and no claims have been canceled herein. Therefore, claims 9-15 and 19-34 are now pending in this application. Applicants respectfully request reconsideration of these claims for at least the reasons presented below.

#### **35 U.S.C. § 112 Claim Rejections**

The final Office Action has rejected claim 9 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, the Office Action cites the recitation of “the content provider” in claim 9. The Applicants thank the Examiner for carefully reading the claims and for pointing out this informality. Accordingly, amendments have been made herein that are thought to overcome the reasons for the rejection. Specifically, the term upon which the reason for the rejection have been based has been amended herein. Therefore, the Applicants respectfully request reconsideration and withdrawal of the rejections.

#### **35 U.S.C. § 102 Rejection, Youden**

The Office Action rejected claims 9-11 and 12-15 under 35 U.S.C. § 102(b) as being anticipated by U. S. Patent No. 5,606,359 to Youden et al. (hereinafter “Youden”). The Applicant respectfully submits the following arguments pointing out significant differences between claims 9-11 and 12-15 submitted by the Applicants and Youden.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP 2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Applicants respectfully argue that Youden fails to disclose each and every

claimed element. For example, Youden fails to disclose, either expressly or inherently, storing content at a user location before the user specifically requests the content.

Youden is directed to “a video server for providing Video-On-Demand.” Under Youden a “data storage system comprises a large capacity archival storage element with a relatively slow data access and transmission rate and a plurality of smaller capacity disk drive arrays with higher data access and transmission rates than the archival storage element.” (Col. 2, lines 47-51) “In typical use, video data in the archival storage element must be transcribed to the disk drive arrays before the video data is accessible to users.” (Col. 2, lines 54-56) That is, Youden describes pre-stripping or caching content from an archive on a disk array.

However, Youden does not disclose, expressly or inherently, storing content at a user location before the user specifically requests the content. Rather, Youden describes providing content to a user’s location, i.e., a user’s STB, from the disk array only after the content has been selected or requested. See for example, col. 3, lines 10-16 and 42-51. Under Youden “a subset of video from the distributor has been pre-stripped (pre-stored) at the disk array.” However, the Applicants contend that Youden does not disclose the disk array being located at a user location and such a reading of Youden would not be reasonable. Rather, such a disk array would be part of the content distributor’s system(s) and would not be at a user location, e.g., a user’s residence (see claim 33). Youden discloses that “a user, through his or her STB makes a request which is transmitted over one of the communication channels in distribution network 20.” The Applicants note that such a transmission, i.e., of the distribution network, would not be required if the content (i.e., the disk array) was at the user’s location. Furthermore, the Applicants respectfully point out that such a transmission does not occur until after the user specifically requests the content. Thus, Youden does not disclose, expressly or inherently, storing content at a user location before the user specifically requests the content. Rather, Youden describes pre-stripping or caching content on a disk array and then providing the content from the disk array to a user location, i.e., the users STB, only after it has been requested by the user.

Claim 9, upon which claims 10-15, 22-24, and 28-33 depend, recites in part “recording any first segment of each of the plurality of programs that are not already stored at the user location, wherein determining if any first segment of the plurality of programs are not already stored at the user location and recording any first segment that is not already stored at the user location are performed before any user request for any of the plurality of programs.” Youden does not disclose, expressly or inherently, storing content at a user location before the user specifically requests the content. Rather, Youden describes pre-stripping or caching content on a disk array and then providing the content from the disk array to a user location, i.e., the users STB, only after it has been requested by the user. For at least these reasons, the Applicants respectfully request reconsideration and withdrawal of the rejection.

**35 U.S.C. §103 Rejection, Youden in view of Inoue**

The Office Action has rejected claims 12 and 19-32 under 35 U.S.C. § 103(a) as being unpatentable over Youden in view of U.S. Patent No. 5,729,280 to Inoue et al. (hereinafter “Inoue”). The Applicants respectfully submit that the Office Action does not establish a *prima facie* case of obviousness in rejecting these claims. Therefore, the Applicants request reconsideration and withdrawal of the rejection.

In order to establish a *prima facie* case of obviousness, all claimed limitations must first be taught or suggested by the prior art. *See, e.g., DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1360 (Fed. Cir. 2006). The Office Action must then provide an explicit analysis supporting the rejection. *See KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (“a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art”). While the Office Action can use one of several exemplary rationales from the MPEP to support an obviousness rejection under *KSR*, all the rationales still require the Office Action to demonstrate that all the claim elements are shown in the prior art. *See* MPEP §2143. As will be discussed below, the references cited by the Office Action do not teach or suggest each claimed limitation. For example, neither reference teaches or suggests, alone or in combination,

recording all first segments of a plurality of programs sent from a content provider at a user's location before the user requests a program.

As discussed in detail above, Youden does not teach or suggest storing content at a user location before the user specifically requests the content. Rather, Youden describes pre-stripping or caching content on a disk array and then providing the content from the disk array to a user location, i.e., the users STB, only after it has been requested by the user. Thus, Youden also does not teach or suggest recording all first segments of a plurality of programs sent from a content provider at a user location before a user request for a program.

As argued previously, Inoue "relates to a video signal receiver for a near video-on-demand broadcast system." (Column 1, lines 7-8) In one embodiment of Inoue, "the near video-on-demand signal receiver pre-stores the first segment of a desired video program in the buffer memory apparatus." (Column 8, lines 35-38) "When a user requests reception and display of the video program, the pre-recorded segment is immediately reproduced and displayed while the receiver scans the channels carrying the program for the remaining segment of the program." (Column 8, lines 38-42) "Once a transmission of the remaining segment is found, the corresponding video signals are received, stored, reproduced, and displayed." (Column 8, lines 42-44)

That is, Inoue teaches storing a portion of a requested program that can be played out while remaining portions of the program are located and received. As noted in Inoue, "by storing a portion of a selected video program, the receiver can display the stored portion of the program while awaiting or receiving transmission from the broadcaster of a subsequent portion of the program." (Col.3, lines 60-63) However, Inoue does not teach or suggest, alone or in combination with Youden, storing a first segment of each of a plurality of programs. In other words, Inoue does not teach or suggest storing the first segment of all of a plurality of programs. Rather, Inoue like Youden, teaches storing a program that is selected in some way such as identifying a predetermined time the segment will be broadcasted, uploading the segment from a

memory device, programming the device to record the program, etc. (See e.g., Col. 8, lines 49-57) Thus, only selected programs are stored, not a first segment of all programs.

Claim 9, upon which claims 10-15, 22-24, and 28-33 depend, recites in part “recording any first segment of each of the plurality of programs that are not already stored at the user location, wherein determining if any first segment of the plurality of programs are not already stored at the user location and recording any first segment that is not already stored at the user location are performed before any user request for any of the plurality of programs.” Neither Youden nor Inoue teach or suggest, alone or in combination, recording any first segment of each of the plurality of programs that are not already stored at the user location before any user request for any of the plurality of programs. Rather, Youden and Inoue teach storing a program that is selected in some way. For at least these reasons, the Applicants respectfully request reconsideration and withdrawal of the rejection.

Claim 19, upon which claims 20, 21, 25-27, and 34 depend, recites in part “recording a first segment of all of a plurality of programs sent from the content provider at the user location before any user request for the program.” Neither Youden nor Inoue teach or suggest, alone or in combination, recording a first segment of all of a plurality of programs sent from the content provider at the user location before any user request for the program. Rather, Youden and Inoue teach storing a program that is selected in some way. For at least these reasons, the Applicants respectfully request reconsideration and withdrawal of the rejection.

## **CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

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